

REMARKS

Applicants have reviewed this Application in light of the Office Action mailed April 14, 2006. Claims 1-12 and 14-21 are pending in this Application and Claims 1-12 and 14-21 stand rejected. Claims 1, 9, 12, and 16 have been amended to further define various features of Applicants' invention. Claim 13 was previously cancelled without prejudice or disclaimer. Applicants respectfully request reconsideration and favorable action in this case. Claim 22 has been added

Rejections under 35 U.S.C. § 112

Claims 1, 6, 9 and 20 were rejected in the Office Action under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

With respect Claims 1 and 9, the Office Action alleges that the limitation "at least one of the plurality of hosts not having an operating system installed thereon" is not enabled by the Specification which discloses "there is no need to have a fully functional OS present on the hosts." (Specification, Paragraph [0037]). Applicants respectfully traverse this rejection, as "no need to have a fully functional OS present on the hosts" necessarily and inherently includes those situations in which a operating system is not installed on a host. However, to reduce the time and cost required to obtain patent prosecution, Applicants have amended Claims 1 and 9 to overcome this rejection and respectfully request reconsideration and full allowance of Claims 1 and 9 as amended.

With respect to Claims 6, 9, and 20, the Office Action alleges that the disclosure in the Specification of a disk "without regard to whatever data" is on the disk is insufficient to support the recited limitation of a "blank disk."

With respect to claim 6, Applicants traverse the rejection because the disclosure contains a description enabling one skilled in the art to make and/or use the invention. This Examiner's assertion that claim language reciting a "blank" disk is not enabled because the specification recites "without regard to whatever data" is deficient because the quoted text is removed from its context. The sentence from which the Examiner takes the quoted language reads, in its full context:

the fact that a disk has been inserted is treated as user input, without regard to whatever data, if any, is stored on the disk

This text would certainly have enabled someone skilled in the art to understand that the invention could be practiced by inserting a blank disk into a disk drive. First, the explicit inclusion of the words “if any,” which clearly modify the data that is stored on the disk, signal the reader that the disk does not necessarily contain any data at all. Second, the phrasing “the fact that a disk has been inserted is treated as user input, without regard...” while perhaps not the most concise wording imaginable, nevertheless, would convey to anyone of skill in the art that the “user input” is not based on the data stored on a disk, but is instead, the act of inserting a disk into a disk drive. Because the user input is the act of inserting a disk into a disk drive, one skilled in the art would have been enabled to practice the claimed invention by inserting a blank disk into the disk drive. As such, Applicants respectfully traverse the enablement rejection of claim 6 and respectfully request the Examiner to reconsider and withdraw the objection.

With respect to claim 9, Applicants submit that the Section 112 rejection is moot in view of the claim amendment.

With respect to claim 20, Applicant traverse the rejection for reasons analogous to those stated above with respect to claim 6.

Applicants have also amended claim 16 to recite language regarding the inserted disk that substantially matches the precise language used in the specification.

Rejections under 35 U.S.C. § 102

Claims 1-5, 7-19 and 21 were rejected by the Examiner under 35 U.S.C. § 102(b) based upon a public use or sale of the invention. Applicants respectfully traverse and submit the cited art does not disclose or teach all of the elements or steps of the claimed embodiment of the invention.

A. The Form of the Rejection under 35 U.S.C. § 102(b) is Improper Because the Office Action Failed to cite the Prior Art with Sufficient Specificity under 35 U.S.C. § 132 and 37 C.F.R. § 1.104 to Allow Applicants to Adequately Respond to the Rejections

The form of the rejection under 35 U.S.C. § 102(b) is improper because the Office Action fails to cite the prior art properly and with sufficient specificity under 35 U.S.C. § 132

and 37 C.F.R. § 1.104 to allow Applicants to adequately respond to the rejections. The Office Action's explanation for rejection of Claims 1-12 and 14-21 fails to meet the standards required by U.S. statute. For example, according to 35 U.S.C. § 132, the PTO must notify Applicants of the reasons for rejecting each claim and provide such information and references as may be useful in judging the propriety of continuing the prosecution.

The Office Action does not comply with the intent and purpose of 35 U.S.C. § 132 because it fails to properly identify and clearly explain the portions of the cited prior art that allegedly teach each of the limitations of Claims 1-12 and 14-21. With respect to a number of the claims, the Office Action, in a conclusory manner, merely states that the cited prior art allegedly anticipates the limitations of Claims 1-12 and 14-21, but does not explain how such references anticipate the various claims. For example, while the Office Action asserts that the prior art anticipates all elements of Claim 1, it is evident that the cited art does not explicitly teach "receiving a unique identifier (UID) at a cluster controller from each of a plurality of hosts in communication with the cluster controller, at least one of the plurality of hosts not a fully functional operating system present thereon" as recited by amended Claim 1 or the similar limitation of "receiving a unique identifier (UID) at a cluster controller from each of a plurality of hosts in communication with the cluster controller, at least one of the plurality of hosts not having an operating system installed thereon" as recited by Claim 1 prior to amendment herein. Without an explanation of how or why the claims are anticipated by the cited art, Applicants are at an extreme disadvantage in trying to respond to the Office Action.

In addition to defeating the intent and purpose of 35 U.S.C. § 132, Applicants respectfully submit that the Office Action's lack of specificity renders the Office Action non-compliant with the requirements of 37 C.F.R. § 1.104.

37 C.F.R. § 1.104 states:

In rejecting claims for want of novelty or obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be *clearly explained* and each rejected claim specified.

37 C.F.R. § 1.104(c)(2) (emphasis added).

Applicants submit that the cited art describes inventions other than that claimed by the Applicants, and thus 37 C.F.R. § 1.104 requires the Office Action to designate the particular portions of the cited referenced relied on by the Office Action. Since presumably the Examiner read the cited references when making the determination that the cited references teach each and every limitation of Applicants' claims, it should have been reasonably practicable for the Office Action to note which *specific* teachings in the cited references are purportedly relevant to each element of each of Applicants' claims and why such teachings of the references are purportedly relevant.

For at least these reasons, Applicants respectfully submit that the Office Action has failed to cite the prior art properly and with sufficient specificity to allow Applicants to adequately respond to the rejections under 35 U.S.C. § 102(b). Thus, the Office Action has clearly failed to comply with both 35 U.S.C. § 132 and 37 C.F.R. § 1.104. If the Examiner maintains rejections of the pending claims based on the so-called Kick-Start Utility, Applicants respectfully request that such rejections be sufficiently specific and included in a second Non-Final Office Action, such that Applicants have an opportunity to adequately respond to rejections based on same.

B. Claims 1-12 and 14-21 are Not Anticipated by the Kick-Start Utility

Assuming, *arguendo*, that the Office Action has set forth adequate reasons for rejection as contemplated by 35 U.S.C. § 132 (which the Applicants do not concede), rejected Claims 1-12 and 14-21 are not anticipated under 35 U.S.C. § 102(b).

The Office Action bases its rejection on the so-called Kick-Start Utility. Applicants respectfully submit that the Kick-Start Utility does not anticipate amended Independent Claims 1, 9, or 16.

With respect to independent claim 9, the anticipation rejection is insufficient because the Kick-Start Utility does not receive "a unique identifier (UID) at a cluster controller from each of a plurality of hosts in communication with the cluster controller, at least one of the plurality of hosts not having a fully functional operating system present thereon." The Office

Action, in a conclusory manner and without specific detail as to how each and every element of claim 9 is anticipated by the Kick-Start Utility, asserts “the limitation [sic] of the claimed invention are taught explicitly in the sighted [sic] documentation in the 892 which describe the Dell PowerApp.web and any feature not clearly taught are [sic] inherent to the Dell PowerApp.web device.”

The rejection fails because the cited references fails to disclose the recited elements as necessarily present. To establish that a claim element is inherent in a prior art reference, extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Inherency, however, may not be established by probabilities or possibilities. *Id.* In the present case, the Office has failed to show a prima facie case of anticipation because the Office has heretofore failed to provide any intrinsic or extrinsic evidence that the Kick-Start Utility “receiv[es] a unique identifier (UID) at a cluster controller from each of a plurality of hosts in communication with the cluster controller, ***at least one of the plurality of hosts not having a fully functional operating system present thereon***” as specifically recited in amended claim 9.

With respect to amended independent claim 1, the Kick Start utility does not teach expressly or inherently where one of the hosts is operating in a pre boot executing environment.

With respect to claim 16, the Kick Start utility does not teach expressly or inherently user input being the insertion of a disk into a disk drive of a first host and then associating a first host name with the first host without regard to data on the disk.

Accordingly, the Kick-Start Utility does not disclose or teach each and every one of the features of the present invention and, as such, cannot create an on-sale bar to Independent Claims 1, 9 and 16. Given that Claims 2-8 depend from Claim 1, Claims 10-12, 14 and 15 depend from Claim 9, and Claims 17-21 depend from Claim 16, Applicants respectfully submit that Claims 2-8, 10-12, 14, 15 and 17-21 are allowable. As such, Applicants respectfully request that the Examiner reconsider, withdraw the rejections under 35 U.S.C. § 102(b) and allow Claims 1-12 and 14-21.

Rejections under 35 U.S.C. § 103

Claims 1-3, 5, 7-12, 14-19 and 21

Claims 1-3, 5, 7-12, 14-19 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,631,442 issued to Steven M. Blumenau (“Blumenau”) in view of U.S. Patent No. 6,378,068 issued to Mark J. Foster et al. (“Foster”) and further in view of *Microsoft's Windows 95 Multimedia Initiative*, CD-ROM Professional by Lawrence Gussin (“Gussin”).

Applicants respectfully traverse and submit that the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiments of the invention obvious. Applicants herein rely on their arguments made in the Response to Office Action dated January 23, 2006, to which the Office Action did not respond or refute, and which the Applicants reiterate below.

The Office Action cites to Blumenau as teaching, among other steps, receiving user input from a first host among a plurality of hosts. The Office Action cites to Foster as teaching the use of ready signals and completion signals. The cited portion of Blumenau discloses a host that sends an “access request (e.g., a poll for volume information) along with the host’s World Wide Name (WWN)...” to a switch and in response the switch “generates and returns a unique ID to the requesting host.” See Col. 22, lines 54-60. Accordingly, Blumenau does not disclose, teach or suggest a system that utilizes user input, namely the insertion of a disk or depressing a power button or reset button to initiate the host naming process. Foster also fails to teach this aspect of the claimed embodiments.

The Office Action cites to Gussin as teaching user input in the form of the detecting the insertion of media in a CD-ROM drive. Applicants note, however, that the AutoPlay feature described by Gussin is used to initiate the installation of the media which has been inserted in the CD-ROM drive. Under the teaching of Gussin, the insertion of a disk or other media into a host would then cause the host to run a so-called AutoPlay application to install, configure and run the application that has been inserted therein. In contrast, the Independent Claims of the present invention use the insertion of a disk in the host to send a signal to the cluster controller which triggers the host-naming process. The application stored on the disk

(if any) is not installed, configured or run during this process. Accordingly, the addition of the Gussin reference to Blumenau and Foster would also not render obvious Independent Claims 1, 9 or 16.

Given that Claims 2, 3, 5, 7 and 8 depend from Claim 1, Claims 10-12, 14 and 15 depend from Claim 9 and Claims 17-19 and 21 depend from Claim 16, Applicants submit that Claims 2, 3, 5, 7, 8, 10-12, 14, 15, 17-19 and 21 are allowable. As such, Applicants respectfully request that the Examiner reconsider, withdraw the rejections under 35 U.S.C. § 103(a) and allow Claims 1-3, 5, 7-12, 14-19 and 21.

In addition to the foregoing, the Section 103(a) rejection of independent claims 1 and 9 as amended is deficient because the cited references do not teach or suggest all claim limitations. Claim 1 recites a host sending user input while in a pre boot execution environment. Claim 9 recites a host sending user input without having a fully functional operating system present.

The Office Action states that Blumenau teaches receiving information from hosts, at least one of whom not having an operating system installed thereon. Applicant respectfully disagrees with the Examiner that Blumenau teaches or suggests hosts operating without an operating system. The Examiner cites to two passages in the Blumenau to support the rejection. Applicant can only guess what portion of the first portion of Blumenau cited by the Examiner, (column 23 lines 31-46), is thought by the Examiner to teach or suggest a host operating with a fully functioning operating system. Certainly, Blumenau does not disclose the lack of a fully functioning operating system explicitly. Applicants assume that the Examiner is basing the rejection on Blumenau's reference to creating entries in a login history table once when a host...initially attempts to access the volume..." Blumenau's reference to "when a host initially attempts to access a volume" is not discussing anything the host does prior to installing a fully functional operating system. Blumenau clearly indicates that communications between its hosts and the volume, which is an external data device accessible to a plurality of hosts, occur after the host operating system(s) are installed. See, e.g., column 18, lines 42-47 ("Steps 301 through 307 are typically performed by data storage system configuration software executing as part of, or in conjunction with the operating system of [one of the] host computing device[s].") Applicants are unable to find

any discussion or suggestion in Blumenau regarding its hosts in any form of pre OS environment. Similarly, the second passage of Blumenau cited by the Examiner (column 10, lines 26-44) does not contain any teaching or suggesting of a pre OS operating environment for its hosts. To the contrary, the discussion of potential differences in the ways different host operating systems may access a common volume reinforces the clear implication that Blumenau's hosts all contain a fully functional operating system. Accordingly, the Section 103 rejection of independent claims 1 and 9 is deficient because the cited references do not teach or suggest all of the claim limitations. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the Section 103(a) rejection of independent claims 1 and 9 and their respective dependent claims.

Claim 4

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Blumenau and Foster as applied to Claims 1-3, 5, 7-12, 14-19 and 21 above, and further in view of U.S. Patent No. 6,098,116 issued to Mark Nixon et al. ("Nixon").

For the reasons discussed above, Claim 4 depends from claims that have been placed in condition for allowance, thereby obviating the present rejections under 35 U.S.C. § 103(a). Applicants request reconsideration, withdrawal of the rejections under 35 U.S.C. § 103(a) and full allowance of Claim 4.

Association of Customer Number

Applicants respectfully request that all papers pertaining to the above-captioned patent application be associated with Customer No. **23640**, and direct all correspondence pertaining to this patent application to practitioners at Customer Number **23640**. All telephone calls should be directed to Joseph P. Lally at 512.322.2680.

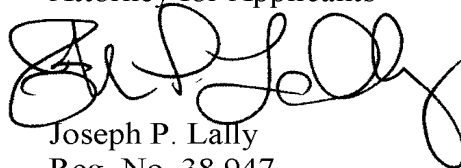
CONCLUSION

Applicants appreciate the Examiner's careful review of the Application. Applicants believe that this case is in condition for allowance. Applicants respectfully request reconsideration of the Application and allowance of Claims 1-12 and 14-22.

The Commissioner is authorized to charge the one-month extension fee of \$120.00, and any further fees necessary, or credit any overpayment, to Deposit Account No. 02-0383 of Baker Botts L.L.P. in order to effectuate thus filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2680.

Respectfully submitted,
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Date: August 14, 2006

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